

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/681,573	05/01/2001	Ignatius M. Zettel	GEMS8081.072	6753
27061	7590	08/24/2004	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, LLC (GEMS) 14135 NORTH CEDARBURG ROAD MEQUON, WI 53097			STORK, KYLE R	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/681,573

Applicant(s)

ZETTEL ET AL.

Examiner

Kyle R Stork

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/15/02.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This office action is in response to the preliminary amendment filed July 2, 2001 and the Information Disclosure Statement filed October 15, 2002.
2. Claims 1-30 are pending. Claims 1, 8, 16, and 25 are independent claims.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per dependent claim 18 the limitation of "further causes the processor to execute acts (A) (E) in response to a user print instruction" is indefinite. It cannot be ascertained whether the applicant means (A) and (E), (A) or (E), or (A) thru (E). For the application of prior art, the examiner assumes that the claim should read "(A) thru (E)."

Dependent claim 19 is rejected based upon its dependency upon claim 18.

5. Claim 20 recites the limitation "the number of publication commands" in the first line. There is insufficient antecedent basis for this limitation in the claim. Claim 20 refers back to claim 16 which does not mention "the number of publication commands."

### ***Claim Rejections - 35 USC § 101***

Art Unit: 2178

## 1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

## Section 2106 of the MPEP states:

(a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material Per Se or Computer Programs Representing Computer Listings Per Se  
**Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory** because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. Computer programs are often recited as part of a claim. Office personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

## 2. Claims 8-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 8-15 "a computer program" is disclosed. This is non-statutory under 35 U.S.C. 101 because such program does not define any structural and functional interrelationships between it and other claimed aspects of the invention which permit the program's functionality to be realized as designated by the MPEP.

Art Unit: 2178

As per claims 16-24 "a printer driver" is disclosed. This is non-statutory under 35 U.S.C. 101 because such print driver does not define any structural and functional interrelationships between it and other claimed aspects of the invention which permit the print driver's functionality to be realized as designated by the MPEP.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 7-13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alam et al. (U.S. 6,336,124) and further in view of Williams (U.S. 5,251,314).

As per independent claim 1 Alam discloses a method to electronically publish media comprising the steps of:

- Publishing the accessed data file (Figures 5-6)
- Initializing a publication enabler capable of converting a data file into at least one publication format (Figure 3; column 5, lines 7-9), wherein the publication enabler is independent of a document creation application used to create the electronic data file (Figure 3; Figures 5-6; In both Figure 5 and Figure 6 it is demonstrated that the document publisher is independent of from the document creation

Art Unit: 2178

application. In both figures, a Text Image Document (518) is created from either a Text/Image Authoring Tool (516) or a Document Image (510). The creation of the Text Image Document is independent of the conversion to the Intermediate Format Document (530) and finally the Output Format Document (534))

- If necessary, converting the accessed data file into another publication format (Figures 5-6, item 530; column 5, lines 60-64)
- Publishing the data file in at least one publication format (Figures 5-6, item 534; column 6, lines 24-26; In both the figures and the text, an output format document is read as the publication format)

Alam fails to disclose receiving a publication instruction from a user. However, Williams discloses receiving a publication instruction from a user (Figure 3, item 82; column 6, lines 14-18).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's method of publishing media with Williams's user request, since it would have allowed a user to request that certain files be published while others are not.

As per dependent claim 2 Alam and Williams disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Alam discloses the method wherein the step of publishing further comprises at least one of the steps of displaying the file on a graphical user interface, transmitting the data file via an electronic messaging system to at least one remote user (column 2, lines 37-40), and storing the data file in memory of a computer (column 2, lines 63-66).

Art Unit: 2178

As per dependent claim 3 Alam and Williams disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Alam fails to disclose routing the data file to at least one of an approving supervisor and a work flow recipient. However, Williams discloses transmitting data files to a work flow recipient (Figure 3, item 92; column 6, lines 49-52).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's method document publishing with Williams method of document routing, since it would have allowed a user to publish a document and route it so that it may be used by a subsequent user (Williams: column 3, lines 50-54).

As per dependent claim 4 Alam and Williams disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Alam discloses the method wherein at least one of the publication format includes at least one of an RTF, HTML, PDF, TIFF, JPEG, GIF, BMP, and fax compression format (column 2, lines 1-11).

As per dependent claim 7 Alam and Williams disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Alam discloses the method further comprising the steps of initializing the publication enabler with an application capable of printing the electronic data file (column 5, lines 21-22).

As per dependent claim 8 Alam discloses a computer program to publish electronic media having a set of instructions that when executed by a computer causes the computer to:



Art Unit: 2178

- Access the electronic media (Figure 3, item 302; column 5, lines 10-15)
- Initialize a media publisher independent of a media creation application and configured to control publication of the electronic media (Figure 3; column 5, lines 7-9), wherein the media publisher is further configured to transform the content of the electronic media into at least one publication format (Figure 3; Figures 5-6; In both Figure 5 and Figure 6 it is demonstrated that the document publisher is independent of from the document creation application. In both figures, a Text Image Document (518) is created from either a Text/Image Authoring Tool (516) or a Document Image (510). The creation of the Text Image Document is independent of the conversion to the Intermediate Format Document (530) and finally the Output Format Document (534))
- Receive a media control instruction to transform the content of the electronic media into at least one publication format (Figure 3, items 304 and 306; column 5, lines 36-39)
- Publish the content of the electronic media in accordance with the received media control instruction (Figures 5-6)

Alam fails to disclose identifying a command from a user to manage electronic media. However, Williams discloses identifying a command from a user to manage electronic media (Figure 3, items 80, 84, and 86; column 6, lines 14-18; column 6, lines 31-40).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's computer program to publish electronic media with Williams program allowing users to request the publishing of electronic

Art Unit: 2178

media, since it would have allowed a user to request certain documents to be published instead of having all documents published automatically.

As per dependent claim 9 Alam and Williams disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. Alam also discloses the computer program wherein the at least one publication format includes media formats foreign to the media creation application (column 2, lines 1-11; column 5, lines 27-35).

As per dependent claim 10 Alam and Williams disclose the limitation similar to those in claim 8, and the same rejection is incorporated herein. Alam also discloses the computer program wherein the at least one publication format includes at least one of a portable document format, a hypertext markup language, an x-markup language, a rich text format, a JPEG format, a GIF format, a TIFF format, encryption formats, a bitmap format, compression format, or electronic messaging formats (column 2, lines 1-11).

As per dependent claim 11 Alam and Williams disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. Alam also discloses the computer program wherein the set of instructions further causes the computer to transmit the content of the electronic media to a document management system capable of storing the contents to a readily identifiable data file (column 2, lines 63-66).

As per dependent claim 12 Alam and Williams disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. Alam also discloses the set of instructions further causing the computer to receive media control instructions and simultaneously transform the content of the electronic media into more than one format

(Figure 5, items 530 and 534: Each item is a document in a different format; Figure 6, items 626, 530, and 534: Again each item is a document in a different format).

As per dependent claim 13 Alam and Williams disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. Alam also discloses the computer program wherein the media publisher is configured to be implemented with a plurality of media creation applications (Figures 5-6, items 504, 508, and 516: These items are specifically used to create media; column 2, lines 28-36: An input format is read as a media creation application).

As per dependent claim 15 Alam and Williams disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. Alam also discloses the computer program wherein the set of instructions further causes the computer to electronically transmit the content via a communication interface including a telephone interface, an electronic message interface, and wireless interface (column 2, lines 37-40).

8. Claims 5-6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alam and Williams and further in view of Chen et al. (U.S. 6,009,442).

As per dependent claim 5 Alam and Williams disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. However, Alam and Williams fail to disclose the method further comprising the step of transmitting the data file to a document management system capable of assigning a coded filename, a storage location, and a file identifier to the data file. However, Chen discloses the method further comprising the step of transmitting the data file to a document

Art Unit: 2178

management system capable of assigning a coded filename, a storage location, and a file identifier to the data file (column 4, lines 21-35, In the reference, a STG file is a data storage structure).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the method of Alam and Williams with the document management system of Chen, since it would have allowed a user to rapidly search for published documents.

As per dependent claim 6 Alam, Williams and Chen disclose the limitations similar to those in claim 5, and the same rejection is incorporated herein. Chen further discloses the method further comprising the step of retrieving the data file from the DMS based on any of the file identifier, coded filename, storage location, an author, a title, a subject, a format, an approver, and a work flow recipient (column 6, lines 18-24; column 4, lines 21-35).

As per dependent claim 14 Alam and Williams disclose the limitations similar to those in claim 8, and the same rejection is incorporated herein. However, Alam and Williams fail to disclose the computer program wherein the set of instructions further causes the computer to retrieve the content of an electronic media from a document management system. However, Chen discloses the computer program wherein the set of instructions further causes the computer to retrieve the content of an electronic media from a document management system (column 6, lines 18-24).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam and Williams' computer program to publish

Art Unit: 2178

electronic media with Chen's program of querying a database for documents, since it would have allowed a user to quickly find published electronic media.

9. Claim 16-21, 23, 25, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alam and further in view of Rothfus et al. (U.S. 6,044,372).

As per independent claim 16 Alam discloses a printer driver embodying a sequence of instructions that when executed by a processor causes the processor to:

- (A) access an electronic data file (Figure 3, item 302; column 5, lines 10-15)
- (D) route the electronic data file to a converter configured to convert the electronic data file into at least one of a number of publication formats (Figure 3; Figures 5-6; In both Figure 5 and Figure 6 it is demonstrated that the document publisher is independent of from the document creation application. In both figures, a Text Image Document (518) is created from either a Text/Image Authoring Tool (516) or a Document Image (510). The creation of the Text Image Document is independent of the conversion to the Intermediate Format Document (530) and finally the Output Format Document (534))
- (E) transmit the converted data file to at least one publication system capable of publishing the converted data file in the at least one publication format (Figure 3, items 304 and 306; column 5, lines 36-39)

Alam fails to disclose:

- (B) display a graphical user interface configured to facilitate user selection of a number of publication commands
- (C) Receive a user selection of at least one publication command

Art Unit: 2178

However, Rothfus discloses (B) display graphical user interface configured to facilitate user selection of a number of publication commands (Figure 5; column 11, lines 48-60). Rothfus also discloses (C) receive a user selection of at least one publication command (column 11, lines 48-51).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the printer driver of Alam with the graphical user interface and the user selection of Rothfus, since it would have allowed users to graphically select a publishing format.

As per dependent claim 17 Alam and Rothfus disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. However, Alam fails to disclose the instructions further causing the processor to display the GUI in response to a document management instruction. However, Rothfus discloses displaying the GUI in response to a document management instruction (column 11, lines 48-51).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the printer driver of Alam with Rothfus' instructions to display the GUI in response to a document management instruction, since it would have allowed a user enter a document management instruction and then chose the desired printer driver from the GUI.

As per dependent claim 18 Alam and Rothfus disclose the limitations similar to those in claim 17, and the same rejection is incorporated herein. However, Alam discloses printer drive wherein the sequence of instructions further causes the processor to execute acts:

Art Unit: 2178

- (A) access an electronic data file (Figure 3, item 302; column 5, lines 10-15)
- (D) route the electronic data file to a converter configured to convert the electronic data file into at least one of a number of publication formats (Figure 3; Figures 5-6; In both Figure 5 and Figure 6 it is demonstrated that the document publisher is independent of from the document creation application. In both figures, a Text Image Document (518) is created from either a Text/Image Authoring Tool (516) or a Document Image (510). The creation of the Text Image Document is independent of the conversion to the Intermediate Format Document (530) and finally the Output Format Document (534))
- (E) transmit the converted data file to at least one publication system capable of publishing the converted data file in the at least one publication format (Figure 3, items 304 and 306; column 5, lines 36-39)

Alam fails to disclose:

- (B) display a graphical user interface configured to facilitate user selection of a number of publication commands
- (C) Receive a user selection of at least one publication command

However, Rothfus discloses (B) display graphical user interface configured to facilitate user selection of a number of publication commands (Figure 5; column 11, lines 48-60). Rothfus also discloses © receive a user selection of at least one publication command (column 11, lines 48-51). Rothfus also discloses performing steps in response to a user print instruction (column 11, lines 45-60).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the printer driver of Alam with the graphical user interface, user selection, and user print instruction of Rothfus, since it would have allowed users to graphically select a publishing format and then executed the creation of the published media.

As per dependent claim 19 Alam and Rothfus disclose the limitations similar to those in claim 18, and the same rejection is incorporated herein. Alam discloses the print driver wherein the sequence of instructions further causes the processor to recognize a print instruction from any software application capable of printing the electronic data file (column 2, lines 28-36).

As per dependent claim 20 Alam and Rothfus disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam discloses the print driver wherein the number of publication commands include a publish command including a convert to a PDF command and a convert to HTML command (column 2, lines 28-36).

As per dependent claim 21 Alam and Rothfus disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam discloses the print driver wherein the number of publication formats include PDF, JPEG, GIF, TIFF, HTML, XML, RTF, TXT, DOC, encryption, PPT, and ZIP (column 2, lines 28-36).

As per dependent claim 23 Alam and Rothfus disclose the limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam discloses routing



Art Unit: 2178

the converted data file to a supervisor and a subsequent document designate (column 2, lines 37-40).

As per independent claim 25 Alam discloses a system for publishing documents to a document management system comprising:

- A computerized network (column 2, lines 37-40)
- A readable memory electronically linked to a network (column 2, lines 63-66)
- A plurality of computer connected to the network (column 2, lines 37-40)
- One or more publication formats including publications formats non-native to a creation document (column 2, lines 1-11; column 5, lines 27-35)
- The processing unit is further programmed to convert a document to at least one of the publication formats (column 2, lines 1-11)

Alam fails to disclose:

- A graphical user interface display
- A processing unit programmed to call the GUI on demand and enable a user selection of one or more publication formats

However, Rothfus discloses:

- A graphical user interface display (Figure 5; column 11, lines 48-60)
- A processing unit programmed to call the GUI on demand and enable a user selection of one or more publication formats (Figure 5; column 11, lines 48-60)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam's system of publishing documents with

Art Unit: 2178

Rothfus' graphical user interface, since it would have allowed users to enter choices graphically with a mouse instead of having to key input choices with a keyboard.

As per dependent claim 30 Alam and Rothfus disclose the limitations similar to those in claim 25 and the same rejection is incorporated herein. Alam further discloses the system wherein the processing unit is programmed to print regardless of which application a user desires to print (Figure 3; Figures 5-6).

10. Claim 22 and 26-27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alam and Rothfus and further in view of Chen et al.

As per dependent claim 22 Alam and Rothfus disclose the limitations similar to those in claim 16 and the same rejection is incorporated herein. Alam and Rothfus fail to disclose retrieving an electronic data file from a document management system capable of storing the electronic data file. However, Chen discloses retrieving an electronic data file from a document management system capable of storing the electronic data file (column 6, lines 18-24).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the print process of Alam and Rothfus with the document management system of Chen, since it would have allowed a user to store and retrieve printed documents.

As per dependent claim 26 Alam and Rothfus disclose the limitations similar to those in claim 25 and the same rejection is incorporated herein. Alam and Rothfus fail to disclose a system wherein the processing unit is further programmed to automatically generate a document identifier and assign the document identifier to the document.

Art Unit: 2178

However, Chen discloses a system wherein the processing unit is further programmed to automatically generate a document identifier and assign the document identifier to the document (column 4, lines 9-11; column 4, lines 22-27).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the Alam and Rothfus' system with Chen's system of assigning a document identifier to a document upon document generation, since it would have allowed a user to save a document with a default set of document attributes that are set upon document creation.

As per dependent claim 27 Alam and Rothfus disclose the limitations similar to those in claim 25 and the same rejection is incorporated herein. Alam and Rothfus fail to disclose a system wherein the processing unit is further programmed to assign a document title, document subject, and document author to the document. However, Chen discloses a system wherein the processing unit is further programmed to assign a document title, document subject, and document author to the document (column 4, lines 9-11; column 4, lines 22-27: Here a file name is a document title; column 4, lines 31-35: Here a document category is a document subject).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam and Rothfus' system for document publishing with Chen's system or saving documents with attributes, since it would have allowed a user to search for documents by one of a plurality of document characteristics.

Art Unit: 2178

11. Claim 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alam and Rothfus and further in view of Ouchi (U.S. 6,370,567).

As per dependent claim 24 Alam and Rothfus disclose limitations similar to those in claim 16, and the same rejection is incorporated herein. Alam and Rothfus fail to disclose displaying a listing of document approving supervisors. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12; column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the print driver of Alam and Rothfus with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.

As per dependent claim 28 Alam and Rothfus disclose limitations similar to those in claim 25, and the same rejection is incorporated herein. Alam and Rothfus fail to disclose displaying a listing of document approving supervisors. However, Ouchi discloses displaying a list of addresses in response to a user instruction (Figure 12; column 10, lines 63-66: The setting of the BRANCH INDICATOR is a user instruction). Although Ouchi is silent on the distribution list specifically being a listing of approving supervisors, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have listed supervisors on a distribution list.

Art Unit: 2178

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined the print driver of Alam and Rothfus with Ouchi's listing of supervisors in order to allow users to quickly notify selected supervisors of the publication of a document through a single message.

12. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alam, Rothfus, Ouchi and further in view of Williams.

As per dependent claim 29 Alam and Rothfus disclose limitations similar to those in claim 25, and the same rejection is incorporated herein. Alam, Rothfus, and Ouchi fail to disclose routing the data file to at least one of an approving supervisor and a work flow recipient. However, Williams discloses transmitting data files to a work flow recipient (Figure 3, item 92; column 6, lines 49-52).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alam, Rothfus, and Ouchi's system of document publishing with Williams method of document routing, since it would have allowed a user to publish a document and route it so that it may be used by a subsequent user (Williams: column 3, lines 50-54).

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Estrada (US 2004/0070609): Discloses a system with updates to supervisor.

Art Unit: 2178

- Gullotta et al. (US 2002/0156904): Discloses a system with updates to supervisor.
- Gardner et al. (US 6725429): Primary and secondary documents.
- Herr-Hoymann et al. (US 5727156): Electronic document publishing.
- Day et al. (US 6243722): Network based document retrieval.
- Payne et al. (US 6092090): Electronic document management system.
- Kelly et al. (US 5173853): Data format conversion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (703) 605-1203. The examiner can normally be reached on Monday-Friday (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork

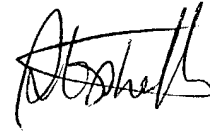
Application/Control Number: 09/681,573

Page 21

Art Unit: 2178

Patent Examiner

Art Unit 2178

A handwritten signature in black ink, appearing to read 'Stephen S. Hong', with a stylized, cursive script.

**STEPHEN S. HONG  
PRIMARY EXAMINER**